

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

HÖNIG

Confirmation No. 9981

Serial No. 09/938,331

Group Art Unit: 1733

Filed: August 23, 2001

Examiner: B. Musser

For: **METHOD AND APPARATUS FOR APPLYING A PLASTIC EDGE STRIP TO A PLATE-LIKE WORKPIECE AND SUCH A WORKPIECE**

DECLARATION UNDER 37 C.F.R. 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22231-1450

Sir:

NOW COME the undersigned and declare that:

1. I, the undersigned, am the sole inventor named in the above-identified application for Letters Patent.
2. The following facts show completion of the presently claimed invention in a WTO member country, namely South Africa, on a date prior to the second (2nd) day of July NINETEEN NINETY-NINE (1999), which date is, upon information and belief, the priority date, e.g. the filing date of U.S. Patent Application No. 09/346,796 to Shanahan et al. (now U.S. Patent No. 6,231,327 and hereinafter referred to as "the Shanahan et al. priority date").
3. I and those working under my direction invented a method and apparatus for applying a plastic edge strip to a plate-like workpiece prior to the Shanahan et al. priority date as shown more completely below.
4. Attached hereto and made a part of this affidavit are a number of Exhibits. These exhibits are listed below.

A Letter from patent attorney confirming consultation on 29 June 1999

5. Exhibit A is a copy of a letter to me from my patent attorney in South Africa, Alan Lewis dated 29 June 1999. The date of 29 June 1999 was prior to the Shanahan et al. priority date. Exhibit A shows that I had a consultation with Mr Lewis at my offices on 29 June 1999 with regard to filing a South African patent application accompanied by a provisional specification in respect of my invention entitled "Wood Edge". Exhibit A shows that I discussed my invention with Mr Lewis with reference to a prototype apparatus and a drawing and that I provided Mr Lewis with sufficient information to enable him to prepare a draft specification. Pursuant to my consultation with Mr Lewis on 29 June 1999, Mr Lewis prepared and filed a South African provisional patent application (Application No. 99/4442), from which this present application in the United States claims priority. The reference to the prototype apparatus shows that when I consulted with Mr Lewis on 29 June 1999 I had already reduced the invention into practice.

B. Patent attorney's note of consultation on 29 June 1999

6. Exhibit B is a copy of consultation notes dated 29 June 1999 made by Mr Lewis of my said consultation with him on 29 June 1999. The date of 29 June 1999 was prior to the Shanahan et al. priority date. Exhibit B shows two diagrams, one of the diagrams showing a plate-like wooden workpiece having edging on a curved edge thereof and the other diagram showing a plate-like wooden workpiece having edging on a straight edge thereof. Following the drawings there are various numbered notes which read as follows:

- "1) Adhesive – solvent based polyurethane – Genkem – VAW 595
Helmilin –Werke
- 2) Wood surface not prepared
- 3) Adhesive can be applied before or in the same process
- 4) Soft PVC, thermoplastic
- 5) Could move board or forming components
- 6) Could do curve
- 7) Angled sides – do separately
- 8) Surface could be patterned
- 9) Could hot foil
- 10) Temp about 180° - Could be as much as 220° - Almost at extrusion temperature
- 11) Hardy sole inventor
- 12) File i.n.o. Plastrim Inv. CC"

C. Drawings of apparatus



7. Exhibit C is a copy of a sheet of drawings which I furnished to Mr Lewis during my consultation with him on 29 June 1999 and to which Mr Lewis refers in paragraph 2 of Exhibit A. The date of 29 June 1999 was prior to the Shanahan et al. priority date. Exhibit B shows the apparatus of my invention for applying a plastics edging to a wooden board. These drawings were used by Mr Lewis in my South African provisional patent application 99/4442.

D. **Confirming affidavit by my patent attorney**

8. I will annex, as Exhibit D, an affidavit by my patent attorney confirming what is set out in paragraphs 5 to 7 above.

9. The work done as reported on each of Exhibits A through C was done in South Africa, a WTO member country. The material written on the originals corresponding to these exhibits was written in South Africa.

10. I actually reduced to practice the subject matter of the present invention prior to the second (2nd) day of July, NINETEEN NINTY NINE (1999), the Shanahan et al. priority date.

11. All statements made herein of my own knowledge are true. All statements made herein upon information and belief are believed to be true. I understand that wilful false statements and the like are punishable by fine or imprisonment, or both, under the provisions of 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

12. Further, declarant sayeth naught.

13. WITNESS my signature below on the indicated date.

18.4.05
Date


Erhard HÖNIG

THUS SIGNED and SWORN before me at Parkview this the 18th day of APRIL 2005, the deponent having acknowledged that he knows and understands the contents of this affidavit, that he regards the oath as binding on his conscience and that he has no objection to taking the prescribed oath.


WITNESS

COMMISSIONER OF OATHS

Commissioner of Oaths
Lesley Blake
Practising Attorney RSA
2nd Floor, No. 8 Arnold Road
Breeburg, Johannesburg



'A'

FAX TRANSMISSION
FROM: 011 642-1914

Pages Transmitted (2)
(Including this page)

To Fax No: (011) 673-5651

Plastrim Investments CC
PO Box 82838
SOUTHDALE
2135

A-Z(P) Patents Local
AL/BSJ/vd Mr Lewis

29 June 1999

Attention: Mr Erhard Honig

Dear Hardy

Proposed Provisional Patent Application in the name of **Plastrim Investments CC**
"Wood Edge" - Our ref: A-Z(P) Patents Local AL/BSJ/vd

1. I refer to the consultation which I had with you on 29 June 1999 at your offices.
2. During the consultation your new invention in regard to "Wood Edge" was discussed, with reference to a prototype apparatus and a drawing.
3. I confirm your instructions to prepare and file a patent application accompanied by a provisional specification at the South African Patent Office for the invention.
4. As you are aware, in order for an invention to be patentable, it must be both "new" and inventive. We naturally assume that you are satisfied that the invention complies with these requirements and that the invention has sufficient commercial value to justify the cost of preparing and filing the patent application, which will be in the region of R4500 to R6000.
5. I believe that we have sufficient information to enable us to prepare a draft specification and I am proceeding therewith. If I require any further information I will contact you.
6. I confirm that the patent application is to be filed in the name of **Plastrim Investments CC**, naming Erhard Hönig as the sole inventor.
7. I will be contacting you again in the near future. In the meantime, please

ensure that the novelty of the invention is not prejudiced by use, or by any publication or disclosure thereof, until such time as the patent application has actually been filed.

Yours faithfully
ADAMS & ADAMS

ALAN LEWIS

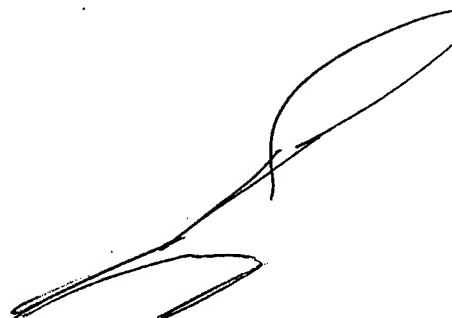
A handwritten signature in black ink, appearing to be 'Alan Lewis', located in the bottom right corner of the page. The signature is fluid and cursive, with a long horizontal stroke at the end.

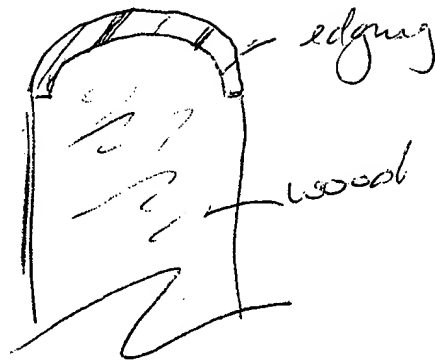


EXHIBIT B

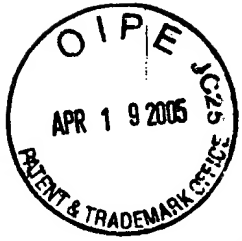
AL
Hardy Hong

Consultation at
Plastum

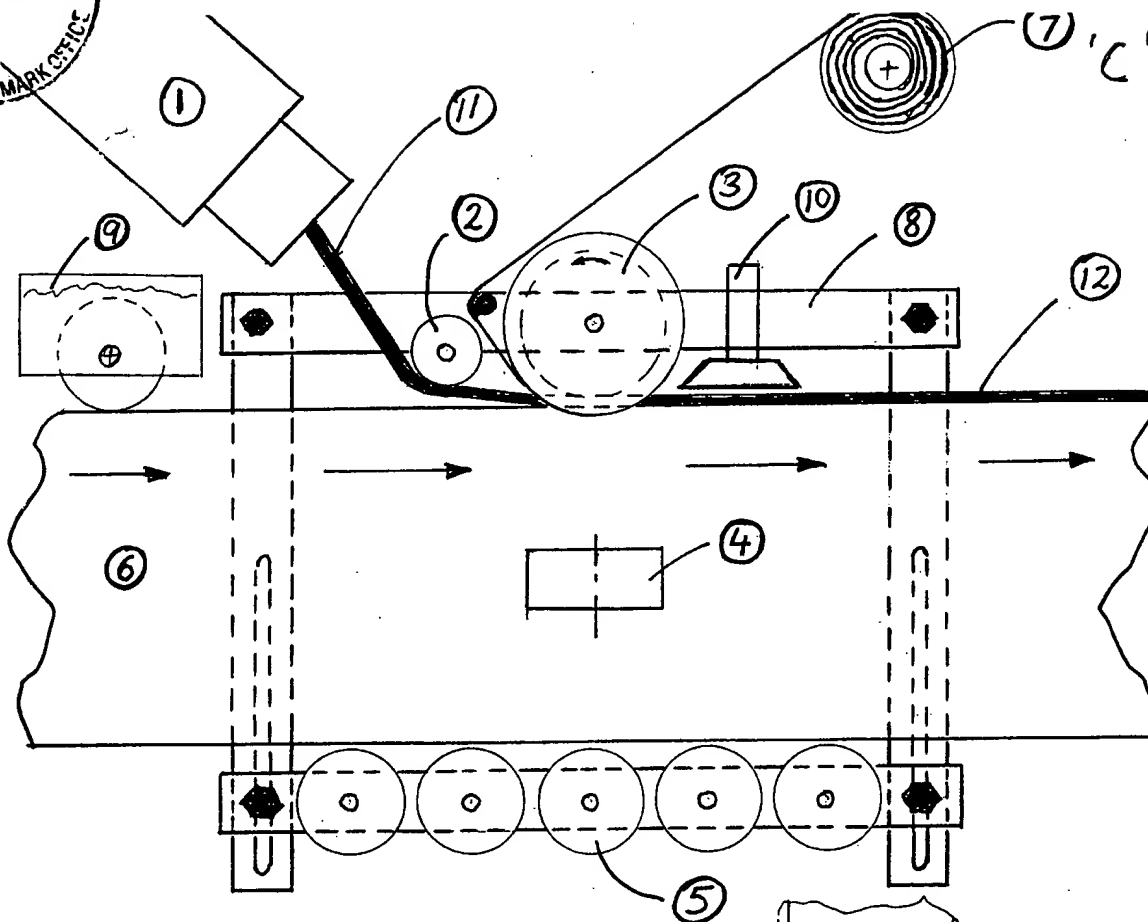
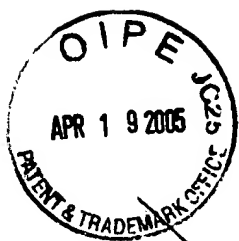
'B'
29/6/94
11:30h



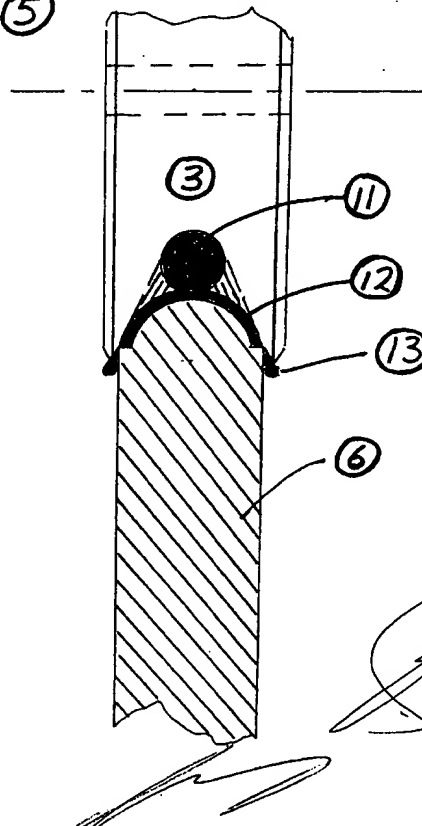
- 1) Adhesive - solvent based polyurethane
adhesive - Guntex - VAW 595
Helmut-Werk
- 2) Wood surface not prepared.
- 3) Adhesive can be applied before
or in same process.
- 4) Soft PVC, thermoplastic.
- 5) Could move board or forming
components
- 6) Could do curve.
- 7) Angled sides - do separately.
- 8) Surface could be patterned.



- 9) Could not find
- 10) Temp about 180° or, Could be as much as 220° - almost at extrusion temperature.
- 11) Hardly sole inventor.
- 12) File in U.S. Patent Inv. CE.



1 - PLASTIC EXTRUDER
2 - GUIDE WHEEL
3 - FORM WHEEL
4 - FEED WHEEL
5 - PRESSURE WHEELS
6 - BOARD
7 - DECORATIVE FOIL
8 - MACHINE FRAME
9 - ADHESIVE APPLICATOR
10 - COOLING (WATER-AIR)
11 - EXTRUDED PLASTIC
12 - FORMED PLASTIC
13 - EXCESS PLASTIC



BEST AVAILABLE COPY



EXHIBIT D

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AFFIDAVIT OF ALAN LEWIS

I, the undersigned, **ALAN LEWIS**, do hereby make oath and say:

1.

The facts contained herein are, save where the contrary is indicated, within my own personal knowledge and belief and these facts are, to the best of my knowledge and belief true and correct.

2.

I am an adult male patent attorney practising as such as a senior partner of the firm Adams & Adams at 3rd Floor, 23 Wellington Road, Parktown, Johannesburg, Republic of South Africa.

3.

I have read the affidavit of Erhard Hönig deposed to on 18 April 2005 in support of the abovementioned patent application and confirm the facts stated in paragraphs 5, 6 and 7 thereof insofar as they relate to me.


ALAN LEWIS

THUS SIGNED and SWORN before me at *Parktown* this the *18th* day of *APRIL* 2005, the deponent having acknowledged that he knows and understands the contents of this affidavit, that he regards the oath as binding on his conscience and that he has no objection to taking the prescribed oath.


COMMISSIONER OF OATHS

Commissioner of Oaths
Lesley Blake
Practising Attorney RSA
2nd Floor, No. 8 Arnold Road
Beechburg, Johannesburg